

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

For: REFLECTED LIGHT GLARE MINIMIZATION FOR ATHLETIC CONTEST PARTICIPANTS WHILE PROVIDING A NON-VERBAL COMMUNICATION

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUPPLEMENTAL REPLY BRIEF

Sir:

This is Appellants' Supplemental Reply Brief responsive to the Supplemental Examiner's Answer mailed April 28, 2006, in connection with the above-captioned patent application. Appellants present this brief to clarify points raised by the Examiner in the Supplemental Examiner's Answer.

Appellants believe that there is no fee required for the submission of this Reply Brief. However, the Commissioner is hereby authorized to charge Deposit Account No. 50-0206, if deemed necessary.

Claims 21-24 and 31-34 are currently rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 4,719,909 to Micchia *et al* ("Micchia") in view of U.S. Patent No. 1,300,592 to Essig

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(“Essig”). Claims 26-30 and 36-40 are currently rejected under 35 U.S.C. § 103(a) over Micchia in view of Essig and further in view of US Patent No. 5,470,351 to Ross *et al* (“Ross”). Claims 25 and 35 are currently rejected under 35 U.S.C. § 103(a) over Micchia in view of Essig and further in view of Ross and US Patent No. 4,522,864 to Humason *et al* (“Humason”).

The Examiner indicates in footnote 1 of the Supplemental Examiner’s Answer that a search of the record has not produced any indication of where the Examiner’s statement “it would have been obvious to one having ordinary skill in the art at the time of the invention ... to further decorate the applied patch” is located. As indicated on page 2 of the Reply Brief, the Examiner made this statement on pages 9-10, specifically starting at the second to last line of page 9 to the first line of page 10 of the Examiner’s Answer. The Examiner’s relies on the ornamental patch of Essig and summarily concludes that Essig teaches one of ordinary skill in the art to drastically modify the uniform black eye-patch of Micchia for no other purpose but to meet Appellants’ claimed “communication” limitation. This is a clear example of improper hindsight.

The Examiner further admits that Essig and Micchia are directed to completely different endeavors, but nevertheless dismisses this fact as “irrelevant.” More specifically, in the Supplemental Examiner’s Answer mailed April 28, 2006, at the second to last line of page 2, the Examiner admits that “[t]he fact that Essig is used for a different purpose is irrelevant and an artisan would not consider including the perfume feature of Essig in Micchia.” However, these conclusions are only possible through the benefit of improper hindsight. In determining the propriety of the Patent Office case for obviousness, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art

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having the reference before him or her to make the proposed substitution, combination, or other modification. *In re Linter*, 458 F.2d 1013, 1016, 173 U.S.P.Q. 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). As generally understood, the teachings of the prior art are taken as a whole and cannot be combined in a piecemeal fashion for the sole purpose of meeting Appellants’ claimed inventions. The Examiner has failed to meet the proper requirements for obviousness and has further misinterpreted the actual teachings of the applied references and what would have been obvious to one of ordinary skill in the art from the disclosures of Micchia and Essig.

On page 3 of the Reply Brief, Appellant’s state that “the Examiner has failed to even identify any perceived problem in Micchia and how a decorative butterfly body tattoo can solve any problem in Micchia.” On page 3, line 3 of the Supplemental Examiner’s Answer mailed April 28, 2006, the Examiner responds by indicating that “Essig teaches it is desirable to have a

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decorative decal when the decal is worn by a person and the decal is worn in plain view.” However, the Examiner’s conclusory statement nevertheless fails to indicate any perceived problem in Micchia. Further, Micchia specifically teaches a *uniform* black patch positioned below the eye for optimal light absorbing properties. *See* Micchia, col. 2, lines 37-45. Therefore, a decorative image, such as the butterfly image of Essig, is contrary to the teachings of Micchia’s black uniform patch. The disclosure of Micchia in fact teaches away from the proposed combination and modifications.

On page 3 of the Supplemental Examiner’s Answer, the Examiner states that “the term communication is a broad term and needs to be interpreted as such.” The Examiner further argues that the “interpretation used by the examiner … gives it broad meaning which is consistent with the broad term chosen by the applicant.” However, the Examiner has conveniently ignored the requirement that the claims must be given their broadest *reasonable* interpretation *consistent with the specification*. *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2d 1664, 1667 (Fed. Cir. 2000). Each claim term has meaning and cannot be interpreted to be devoid of any meaning. By ignoring positively recited limitations, the Examiner has improperly construed the claims and applied references that fail to render the claimed inventions obvious.

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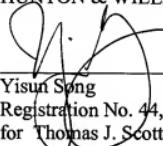
CONCLUSION

For at least the foregoing reasons, the rejections of claims 21-40 should be reversed.

Respectfully submitted,

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